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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,406	03/01/2004	Ernesto Garcia	19.0372	2405

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EXAMINER	
SMITH, MATTHEW J	

ART UNIT	PAPER NUMBER
3672	

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/708,406	GARCIA ET AL.	
	Examiner	Art Unit	
	Matthew J. Smith	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 July 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5, 16, 17, 19-23, and 33-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is directed to a judicial exception to 35 U.S.C. 101 (i.e., an abstract idea) and is not directed to a practical application of such judicial exception (e.g., because the claim does not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result).

Claims 1 and 33, "automatically adjusting", and claim 19, "automatically adjust", are considered not to produce a concrete, useful, or tangible result.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 36 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Millheim (4794534).

Millheim discloses a method for drilling from an offsite location comprising: selectively advancing a drilling tool (col. 7, line 27) operated according to a wellsite setup; collecting wellsite parameters from sensors (col. 7, lines 29-36); transmitting the parameters to an offsite control center 20; analyzing the parameters (col. 9, lines 57-68); determining a drilling command (col. 10, line 57); and transmitting and implementing the drilling command to the tool (via the wellsite engineer) by changing the wellsite setup (also via the wellsite engineer).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10, 15-29, 32-35, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millheim in view of Streetman (6456092).

Millheim discloses a method for drilling a wellbore located at a wellsite having a drilling rig 10 with a downhole drilling tool (col. 4, line 7) comprising: selectively advancing the drilling tool operated according to a wellsite setup; collecting wellsite parameters from downhole sensors (col. 5, line 18); transmitting at least a portion of the

wellsite parameters to an offsite control center 20; performing an analysis of the wellsite parameters (col. 10, lines 34-36); and manually adjusting the wellsite set up from the offsite center 20 or surface control unit 18 based on the analysis of the wellsite parameters (col. 10, line 54); establishing an offsite communication link (col. 5, lines 31-34) between the offsite control center and the wellsite; establishing an onsite communication link between the surface control unit and a surface system of the wellsite (col. 6, lines 14-15); an offsite communication link between the offsite control center and the downhole tool (col. 7, lines 37-39); parameters transmitted via satellite 24 (col. 5, lines 39-43); the transmitting and adjusting steps performed in real time (col. 2, line 68); the transmitting and adjusting steps performed at intervals (col. 6, lines 60-63); the drilling tool being a measurement while drilling tool (col. 7, line 27); an offsite processor 61 adapted to generate an analysis of the wellsite parameters and make decisions; an offsite controller (col. 9, lines 57-68) adapted to adjust the wellsite setup according to the analysis of the wellsite parameters; and the offsite center having a monitor (fig. 6) for displaying the wellsite parameters but not automatically adjusting from an offsite center.

Streetman discuss automatically adjusting wellsites equipment from an offsite center based on analysis (col. 2, lines 50-57).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to automatically adjust wellsite equipment from an offsite center, as discussed by Streetman, in order to control a large number of wells from one site (Streetman, col. 6, lines 31-33).

Claims 11-14, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millheim in view of Streetman as applied to claims 1 and 19, respectively, above, and further in view of Alvarado et al. (5864772).

The combination discloses transmitting well data to a remote location but not deploying a wireline tool with sensors into the wellbore.

Alvarado et al. show a wireline tool 10 with sensors transmitting data to a remote location.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a wireline tool to gather well data to be transmitted to a remote location, as shown by Alvarado et al., since it is well known to gather data from a wireline tool as well as a drilling tool.

Response to Arguments

Applicant's arguments, see page 10, filed 17 July 2006, with respect to the rejection of claims 1-9, 15-27, 29, and 32-35 under 35 U.S.C 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new rejection is made in view of Streetman. The examiner contends Streetman discusses offsite control of a well operation. Even though the operation is not drilling, one of ordinary skill would see the advantages of using this concept for drilling. With respect to claim 36, the examiner notes the wellsite

engineer can carry out the transmitting and implementing steps. The examiner further notes the automatic adjustment is in dependent claim 37.

The 35 U.S.C. 101 rejection was not previously presented due to a clarification of the Patent Office policy. One possibility to overcome this rejection is to adjust one parameter, such as applicant's pump 29.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Smith whose telephone number is 571-272-7034. The examiner can normally be reached on T-F, 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

~~David Bagnell~~
~~Supervisory Patent Exa~~miner
Art Unit 3672

MJS MJS
13 September 2006

Jennifer H. Gay
Primary Examiner